

REMARKS

In the outstanding *Final Rejection* all of the pending claims were rejected under 35 USC §102(b) as anticipated by, or in the alternative, as obvious over United States Patent No. 3,214,347 to *Grekel et al.* These rejections are not supported by the reference and should be withdrawn. The present invention is directed to a method of stabilizing the color of a finished organic product by adding 100 ppm to 50,000 ppm water. Claim 1 is representative:

1. A process for preparation of a color stable organic compound/water mixture from an organic compound selected from the group consisting of C₁ to C₆ carboxylic acids, ketones having boiling points from 154°C to 170°C, and esters having boiling points from about 168°C to about 250°C, the process comprising combining the organic compound with water under conditions of agitation to form a mixed solution of the organic compound and water having a consistent concentration of water comprising from about 100 ppm to about 50,000 ppm water to produce the color stable organic compound/water mixture, wherein the color stable organic compound/water mixture has an APHA color value of 15 or less after being boiled for at least one hour at one atmosphere of pressure.

Grekel et al. does not remotely suggest the claimed subject matter. Consider the text of *Grekel et al.* at Col. 7, line 69:

To obtain highly purified n-butyric acid from *the dry acid mixture* mentioned immediately above, said mixture is fed to a *third column* operated at a bottoms temperature of 157.8°C. (635 mm.) and at a top tower temperature of 138.9°C. (500 mm.).

The “third column” is operated well above the boiling point of water and therefore any water left in the product is at least presumeably removed. *Grekel et al.* clearly contemplates a dry product, teaching away from the invention. The Examiner points to the fact that the *Greckel et al.* production system uses water reflux. This does not support a rejection of the method of the invention which requires a “consistent”, that is

unchanging, concentration of water from about 100 ppm – 50,000 ppm as occurs when the product is mixed and stored with water as is described in the application as filed. The *Grekel et al.* reference nowhere suggests maintaining such amount of water in the product. The Examiner's rejection is thus based on a contention that such a level of water addition is somehow maintained in the system during the manufacturing process. This is error and the rejections should be withdrawn.

MPEP §2112, part (IV), specifically prohibits making speculative rejections as the Examiner has done:

**IV. EXAMINER MUST PROVIDE RATION-
ALE OR EVIDENCE TENDING TO SHOW
INHERENCY**

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

Furthermore, *Grekel et al.* does not remotely suggest mixing water with a product to stabilize color of an organic product. The reference teaches to keep distilling the product until all of the water is removed.

Unrecognized properties of materials in the prior art are not teachings which make a later discovery obvious. In this regard, *note, Van Veen v. United States*, 156 USPQ 403, 405-406 (Ct. Cl. 1967):

It is incorrect to hold that an invention was obvious when made, simply because the invention is simple in nature and is easily understood when described in a patent specification. Experience has shown that some of the simplest advances have been the most nonobvious. The prior art, in addition to the Daiber '380 patent mentioned above, cited by the defendant, provides a prior art base which renders the distinctions between the prior art and the subject invention even more significant. None of the prior art cited by defendant copes with the problem of heat loss through the peripheral seams of the sleeping bag.

Defendant says that under the rule of *General Electric Co. v. Jewel Incandescent Lamp Co.*, 326 U.S. 242, 247-49, 67 USPQ 155, 157-158 (1945), it is of no moment that the prior art (particularly MIL-B-830) failed to recognize that seams of this type would prevent or diminish heat loss. But the Supreme Court has also indicated that "accidental results, not intended and not appreciated, do not constitute anticipation." *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 66 (1923); See also *Tilghman v. Proctor*, 102 U.S. 707, 711 (1880). In the *General Electric* case, the court found that the new use, advantage, or quality was apparent in view of the prior art (see 326 U.S. at 248, 67 USPQ at 157). In the present case, it was not obvious to convert the special 30-inch seam of the Military Specification, even though it happened to be insulated, into the overall peripheral sleeping bag seams of the plaintiff's patent. In that respect the unrecognized quality (i.e., heat-loss prevention) inhering in the short seam of the Military Specification was merely "accidental" and no bar." (Noting the fact that formulations may have had unrecognized properties is an improper basis to reject claims for obviousness.)

5

For the above reasons, the *Final Rejection* of the claims in this case should be withdrawn and this case passed to issue.

Respectfully submitted,



Michael W. Ferrell
Reg. No. 31,158

Ferrells, PLLC
P.O. Box 312
Clifton, Virginia 20124-1706
Telephone: 703-968-8600
Facsimile: 703-968-5500
December 22, 2006